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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,545	09/14/2001	Detlef Palm	512100-2021	7110

7590

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EXAMINER

OH, SIMON J

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/936,545

Applicant(s)

PALM ET AL.

Examiner

Simon J. Oh

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-28 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Papers Received***

Receipt is acknowledged of the applicant's Response to Restriction Requirement and the Information Disclosure Statement, both received on 25 July 2002.

### ***Election/Restrictions***

Applicant's election with traverse of Group I in Paper No. 7 is acknowledged. The traversal is on the ground(s) that an undue burden presented by searching the invention of Groups I and II has not been established. This is not found persuasive because the invention of Group I and the invention of Group II have each acquired a separate status in the art as shown by their different classification. There is no language within the body of the claims of Group I that suggests that a search of methods of transdermal administration of hormones will allow the examiner to find prior art pertinent to the claims of Group I. There is no language within the body of Claim 28 that the method for transdermal administration of hormones requires the use of the invention of Group I, as opposed to the use of a multipack of the prior art. No overlap in areas of prior art searching and no close relationship of the inventions of Groups I and II are seen by the examiner.

The requirement is still deemed proper and is therefore made FINAL.

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Claim 28 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

### ***Claim Objections***

Claim 22 is objected to because of the following informalities: The first letter in the first word of the claim is not capitalized. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101 and 112***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 recites the limitation “respective margins” in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 provides for a method producing a multipack, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is

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intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 25-27 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

To advance the prosecution of Claims 25-27, the examiner treats these claims as being drawn to a method of production involving at least one method step.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-27 rejected under 35 U.S.C. 102(b) as being anticipated by Raffegeau (French Patent No. 2 629 797).

The Raffegeau patent teaches a packaging for individually packaged products in bags (See Page 1, Lines 1-3). This product has a casing of cardboard or plastic in the shape of an inverted “U”, in which the individually packaged bags are inserted and stapled or glued. A wedge in the upper portion of the packaging allows for the thickness of the products contained in the bags and the bags themselves to be compensated (See Page 1, Lines 19-24). An illustration

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is given where more than one wedge is included in the packaging (See Figure 3). The casing of the packaging comprises closure that further comprises a tongue that can be adjusted and inserted into a slot (See Page 1, Lines 25-31; Page 2, Lines 25-27; and Figure 5). The individual bags in the packaging may be perforated along a dotted line (See Page 1, Lines 39-41; and Figure 2). It is the position of the examiner that the illustration of the edges of the individual bags in Figure 1 is sufficient for anticipation of the applicant's claim limitations drawn to superposed sections of the edges of adjacent bags that are offset in parallel. As such, the figure is considered to be an enabling disclosure (See Figure 1; and MPEP § 2125). This packaging is deemed particularly suitable for use with hygiene products and pharmaceuticals (See Abstract, translation not provided).

The preamble of Claim 19 is directed to a process of using the mutipack; it is not given patentable weight as it is considered to be a statement of a future intended use of the claimed product.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raffegau.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The relevant portions of the Raffegau patent are described above in the rejection under 35 U.S.C. 102. It is the position of the examiner that there is sufficient disclosure in the Raffegau patent that the instantly claimed product and process of making that product would be obvious to one of ordinary skill in the art at the time the invention was made. The Raffegau patent describes all of the physical components of the instantly claimed invention, as well as giving enabling disclosures regarding features of the instantly claimed invention. It is the position of the examiner that the disclosure of Raffegau patent is sufficient to obviate the instantly claimed methods of production in their present form. The instantly claimed invention is *prima facie* obvious.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (703) 305-3265. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone numbers for the



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organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Simon J. Oh  
Examiner  
Art Unit 1615

sj  
October 21, 2002

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600